

REMARKS

In the Office Action the Examiner noted that claims 1-9, 11-24, 35, 36, and 41-94 are pending in the application. In the Office Action Summary, the Examiner noted that claims 1-9, 11-24, 35, 36, and 41-94 are rejected. However, in item 30 on page 36 of the Office Action, the Examiner noted that claims 17-18, 55-56, and 76-77 are objected to as being dependent upon a rejected base claim. By this Amendment, claims 1-7, 9, 12-14, 16-17, 22-24, 35, 41-50, 52, 54-55, 59, 61-63, 65-71, 73, 75-76, 81-86, and 88-92 have been amended. No new matter has been added. The Examiner's rejections are traversed below, and reconsideration of all rejected and objected to claims is respectfully requested.

Entry of Amendment Under 37 C.F.R. §1.116

The Applicant requests entry of this Rule 116 Response because: the amendments were not earlier presented because the Applicant believed in good faith that the cited prior art did not disclose the present invention as previously claimed; the amendment of claims 1-7, 9, 12-14, 16-17, 22-24, 35, 41-50, 52, 54-55, 59, 61-63, 65-71, 73, 75-76, 81-86, and 88-92 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and the amendment does not significantly alter the scope of the claim and places the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

Claim Rejections Under 35 USC §102

In items 3-5 on pages 4-6 the Examiner rejected claims 1, 5, 7-8, 11, 15-16, and 35-36 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,537,387, issued to Ando et al. (hereinafter referred to as "Ando").

Ando discloses a storage disk with display data recorded in a lead-in region and an apparatus for recording and/or reproducing the disc. A magneto-optical disc 30 includes a

recordable magneto-optical region 32 on the outer side of a reproduce-only CD region 31, as shown in FIG. 4. See column 6, lines 17-31 of Ando. The CD region 31 includes a CD data region 33 in which data per se, such as play data, is recorded, and a CD lead-in region 34 provided on the inner periphery side of the CD data region. The magneto-optical region 32 includes a magneto-optical data region 35 in which data per se such as play data may be recorded, and a magneto-optical lead-in region 36 provided on the inner periphery side of the magneto-optical data region 32. In a magneto-optical disc, data is recorded magnetically to be read by an optical device, as opposed to the pits and lands of a CD or DVD.

Claim 1 of the present application, as amended, recites:

An optical recording medium comprising:
a read-only storage area;
a non-magnetic writable storage area;
a read-only lead-in area having first control information for both the read-only and non-magnetic writable storage areas; and
a non-magnetic writable lead-in area having second control information relating to the non-magnetic writable storage area.

Therefore, the optical recording medium has a read-only storage area, in which data cannot be written to by the user, and a “non-magnetic writable storage area” in which data can be written. This is in direct contrast to Ando, which discloses a magnetic writable storage area for user data to be written to.

Therefore, Ando does not disclose the feature of a “non-magnetic writable storage area.” Accordingly, Ando does not disclose every element of the Applicant’s claim 1. In order for a reference to anticipate a claim, the reference must teach each and every element of the claim (MPEP §2131). Therefore, since Ando does not teach the features recited in independent claim 1, as stated above, it is respectfully submitted that claim 1 patentably distinguishes over Ando, and withdrawal of the §102(b) rejection is earnestly and respectfully solicited.

Claims 5, 7, 8, 11, 15, and 16 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by Ando. Therefore, it is respectfully submitted that claims 5, 7, 8, 11, 15, and 16 also patentably distinguish over Ando.

Claim 35 also recites the features, of a “non-magnetic writable storage area.” Further, claim 36 depends from claim 35 and includes all of the features of that claim plus additional features which are not taught or suggested by the prior art. Therefore, it respectfully submitted that claims 35 and 36 also patentably distinguish over Ando.

In items 6-7 on pages 7-10 the Examiner rejected claims 45-46, 48, 52-54, 63, 66-68, and 73-75 under 35 U.S.C. §102(b) as being anticipated by Ando.

Claim 45 recites “a system controller which generates identification information to

indicate that the optical recording medium is a hybrid disc having the read-only storage area and the non-magnetic writable storage area.” Claim recites “generating identification information to indicate that the optical recording medium is a hybrid disc having the read-only storage area and the non-magnetic writable storage area.” Therefore, it is respectfully submitted that claims 45 and 66 patentably distinguish over Ando.

Claims 46, 48, 52-54, and 63 depend from claim 45, and claims 67-68 and 73-75 depend from claim 66. Therefore, it is respectfully submitted that claims 46, 48, 52-54, 63, 67-68, and 73-75 also patentably distinguish over Ando.

In item 8 on page 10 the Examiner rejected claim 65 under 35 U.S.C. §102(b) as being anticipated by Ando.

Claim 65 recites “a reproducing unit which reproduces data from the read-only storage area and the non-magnetic writable storage area.” Therefore, it is respectfully submitted that claim 65 also patentably distinguishes over Ando.

In item 9 on pages 11-12 the Examiner rejected claims 84-86 and 90 under 35 U.S.C. §102(b) as being anticipated by Ando.

Claim 84 recites “reproducing data from an optical recording medium having....a non-magnetic writable storage area.” Therefore, it is respectfully submitted that claim 84 patentably distinguishes over Ando.

Claims 85-86 and 90 depend from claim 84. Therefore, it is respectfully submitted that claims 85-86 and 90 also patentably distinguish over Ando.

In item 10 on page 13 the Examiner rejected claim 92 under 35 U.S.C. §102(b) as being anticipated by Ando.

Claim 92 recites “reproducing data from....the non-magnetic writable storage area.” Therefore, it is respectfully submitted that claim 92 patentably distinguishes over Ando.

Claim Rejections Under 35 USC §103

In items 11-14 on pages 14-19 the Examiner rejected claims 2, 3, 4, 6, 9, 12-13, 19, and 21 as being unpatentable over Ando in view of U.S. Patent No. 6,466,735, issued to Kozuka et al. (hereinafter referred to as “Kozuka”).

The Office Action provides absolutely no motivation to combine the cited references. Rather, conclusive statements are made such as “it would have been obvious to one of ordinary skill in the art at the time of the invention to reserve a lead-in and a lead-out area on Ando’s disc similar to Kozuka’s, because the reserve area such as the lead-out area can be used to store

management information." However, "rejection of patent application for obviousness under 35 USC §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." In re Lee 61 USPQ2d 1430 (CA FC 2002)

Thus, as pointed out in In re Lee, the record must support motivation, i.e., there must be something in the record pointing out where the recited motivation can be found. In addition, there must be some discussion on how that purported motivation or suggestion is even relevant to the reference being modified.

Ando discloses a magneto-optical disc having a read-only area and a magneto-optical writable area located outside the read-only area. A magneto-optical disc such as the one discussed in Ando is housed in a protective cartridge to protect the disc, with a sliding access cover on the protective cartridge so that an apparatus to read/write data from/to the magneto-optical disc must be equipped to both accommodate the protective cartridge as well as open the sliding access cover to gain access to the magneto-optical disc. In other words, the magneto-optical disc is used in a very different manner, and with very different devices than the DVD type discs discussed in Kozuka. As a DVD and a magneto-optical disc are two different areas of technology requiring different equipment to either read data from or write data to the respective discs, the Applicant respectfully submits that there is no motivation to combine the two cited references. Therefore, even if the two references combined did teach or suggest all of the features recited in the present application, and the Applicant respectfully submits that they do not, there is no motivation to combine the two references to achieve the features recited in the present application, and the Applicant respectfully requests the §103(a) rejection of claims 2, 3, 4, 6, 9, 12-13, 19, and 21 be withdrawn.

In item 15 on pages 19-20 of the Office Action the Examiner rejected claim 14 under 35 U.S.C. §103(a) as being unpatentable over Ando. Claim 14 depends from claim 1, which, as previously discussed, patentably distinguishes over Ando. Therefore, it is respectfully submitted that claim 14 also patentably distinguishes over Ando.

In item 16 on pages 20-22, the Examiner rejected claims 20, 22, 57-59, 79, and 81 under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Kozuka. As previously discussed, there is no motivation to combine the cited references, and it is respectfully requested that the §103(a) rejection of claims 20, 22, 57-59, 79, and 81 be withdrawn.

In item 17 on pages 22-23 of the Office Action the Examiner rejected claims 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over Ando in view of U.S. Patent 6,243,338,

issued to Mine (hereinafter referred to as "Mine").

Claims 22-23 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by Ando. As previously discussed, Ando does not disclose all of the features recited in claim 1. Further, the deficiencies of Ando are not cured by Mine. For a proper §103 rejection, the cited references must combine to teach all of the features of the application at issue. Therefore, it is respectfully submitted that claims 22-23 patentably distinguish over the cited references, and withdrawal of the §103 rejection is requested.

In items 18-19 on pages 23-26, the Examiner rejected claims 41-44 under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Kozuka. As previously discussed, there is no motivation to combine the cited references, and it is respectfully requested that the §103(a) rejection of claims 41-44 be withdrawn.

In items 20-21 on pages 26-28 of the Office Action the Examiner rejected claims 47, 49, 61, 62, 70, 82, 83, 88, and 91 under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Mine.

Claims 47, 49, 61, and 62 depend from claim 45, claims 70, 82, and 83 depend from claim 66, and claims 88 and 91 depend from claim 84. As previously discussed, these independent claims patentably distinguish over Ando. Further, as the deficiencies of Ando are not cured by Mine, it is respectfully submitted that claims 47, 49, 61, 62, 70, 82, 83, 88, and 91 also patentably distinguish over the cited references.

In items 22-26 on pages 28-32, the Examiner rejected claims 50, 51, 58, 60, 64, 71, 72, 78, 80, 87, and 89 under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Kozuka. As previously discussed, there is no motivation to combine the cited references, and it is respectfully requested that the §103(a) rejection of claims 50, 51, 58, 60, 64, 71, 72, 78, 80, 87, and 89 be withdrawn.

In item 27 on pages 32-33, the Examiner rejected claim 69 under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Mine.

Claim 69 depends from claim 66, which patentably distinguishes over Ando. Further the deficiencies of Ando are not cured by Mine. Therefore, it is respectfully submitted that claim 69 also patentably distinguishes over the cited references.

In item 28 on pages 33-34 the Examiner rejected claim 93 under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Kozuka. As previously discussed, there is no motivation to combine the two cited references. Therefore, it is respectfully submitted that claim 93 patentably distinguishes over the cited references.

In item 29 on pages 34-35 the Examiner rejected claim 94 under 35 U.S.C. §102(a) as being unpatentable over Ando in view of Mine and U.S. Patent No. 6,243,338, issued to Kotuku et al. (hereinafter referred to as "Kotuku").

Claim 94 depends from claim 93 and includes all of the features of that claim plus additional features which are not taught or suggested by the Ando. Further, the deficiencies of Ando are not cured by Mine and/or Kotuku. Therefore, it is respectfully submitted that claim 94 also patentably distinguishes over the cited references.

Allowable Subject Matter

In items 30-31 on page 36 the Examiner objected to claims 17, 18, 55, 56, 76, and 77 as being dependent upon rejected base claims, but indicated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As previously discussed, the independent claims upon which these claims depend all patentably distinguish over Ando and any other cited references. Therefore, it is respectfully submitted that claims 17, 18, 55, 56, 76, and 77 also patentably distinguish over the cited references, and withdrawal of the objection to these claims is respectfully requested.

Summary

In accordance with the foregoing, claims 1-7, 9, 12-14, 16-17, 22-24, 35, 41-50, 52, 54-55, 59, 61-63, 65-71, 73, 75-76, 81-86, and 88-92 have been amended. No new matter has been presented. Claims 1-9, 11-24, 35-36, and 41-94 are pending and under consideration.

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

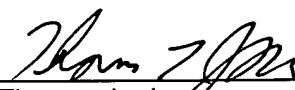
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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